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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,873	01/06/2004	Frederick M. Shofner	SEA-19	4852

31671 7590 08/09/2006

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EXAMINER

VALENTIN, JUAN D

ART UNIT	PAPER NUMBER
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2877

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/752,873

Applicant(s)

SHOFNER ET AL.

Examiner

Juan D. Valentin II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>01/06/2004</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to apparatus and method of fiber length measurements, classified in class 356, subclass 429.
  - II. Claims 12-16, drawn to a method for calibration of length measurement systems, classified in class 250, subclass 252.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus such as a fiber strength testing apparatus.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Steven C. Schnedler on July 25, 2006 a provisional election was made with traverse to prosecute the invention of group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-16 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The claimed invention is directed to non-statutory subject matter. With regards to claim 11, merely identifying; determining; devising; evaluating; analyzing; etc... is not sufficient to constitute a tangible result, since the outcome of the method steps has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application is realized. See OG Notices: 22 November 2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

Practical application that produces a useful, concrete, and tangible result under Section IV determines whether the claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. Sec. 101, sentence 3, in the OG Notice from 22 November 2005 states 'In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible, and concrete."'

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Ghorashi et al. (USPN '394, hereinafter Ghorashi) in view of Shofner et al. (USPN '480, hereinafter Shofner).

**Claims 1, 3, 5**

Ghorashi discloses an apparatus for fiber length measurements from a tapered beard attached to a fiber sampler, comprising a rectangular channel into which a tapered beard is drawn by a gas flow through said channel, said channel having two opposed major sides corresponding to channel width and length, and two opposed minor sides corresponding to channel height and length, one of said major sides comprising a transparent window, and an optical imaging device viewing/scanning (claims 3-5, col. 11, lines 6-12, col. 12, lines 3-13 & lines 52-60) the tapered beard through said transparent window (col. 3, lines 31-39, col. 4, lines 16-26, col. 10, line 59-col. 11, line 12, col. 11, line 33-col. 12, line 12, col. 12, lines 47-60, col. 13, line 59-col. 14, line 3, col. 16, line 6-col. 17, line 31).

Ghorashi substantially teaches the claimed invention except that it fails to show an optical imaging device viewing the tapered beard through said transparent window for acquiring a two dimensional image of the tapered beard. Shofner shows that it is known to provide an optical imaging device viewing the tapered beard through said transparent window for acquiring a two dimensional image of the tapered beard (col. 2, lines 59-64, col. 3, line 13-col. 4, line 14) for a carding machine. It would have been obvious to someone of ordinary skill in the art to combine the device of Ghorashi with the two-dimensional imaging of Shofner for the purposes

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of providing a control system for sensing the physical properties of cotton as it progresses through a gin (Ghorashi, abstract).

**Claims 2 & 10**

Ghorashi as applied above further discloses a digital computer connected to an output of said optical imaging device for storing two-dimensional image data (col. 10, line 59-col. 11, line 12).

**Claim 6**

Ghorashi as applied above further discloses a digital camera (col. 11, lines 7-12).

**Claims 7 & 8**

Ghorashi discloses the claimed invention except for specific size or exact air flow rates. It is inherent to someone of ordinary skill in the art at the time of the invention was made to find the optimum size and optimum air flow rate, since it has been held that discovering an optimum value or workable range of a result effective variable involves only routine skill in the art.

**Claim 11**

The method is taught/suggested by the functions shown/stated/set forth with regards to the apparatus claim 1 as rejected above in view of Ghorashi.

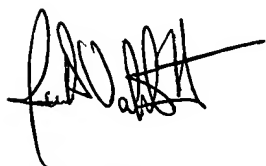
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juan D. Valentin II whose telephone number is (571) 272-2433. The examiner can normally be reached on Mon.-Fri..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Juan D Valentin II  
Examiner 2877  
JDV  
July 31, 2006



HWA (ANDREW) LEE  
PRIMARY EXAMINER

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PRIMARY EXAMINER~~